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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/849,036

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Raimund Schaller

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EXAMINER

MAHYERA, TRISTAN J

ART UNIT

PAPER NUMBER

4173

NOTIFICATION DATE

DELIVERY MODE

11/21/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
pto@gbpatent.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/849,036	<b>Applicant(s)</b> SCHALLER, RAIMUND	
	<b>Examiner</b> Tristan J. Mahyera	<b>Art Unit</b> 4173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) 6-8, 12, 13, 16, 17, 21-52 and 56-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9-11, 14, 15, 18-20 and 53-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/23/2004</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election ***with traverse*** of Group III in the reply filed on 9/27/2007 is acknowledged. The traversal is on the ground(s) that the search for the inventions of Group III would be coextensive, or at least overlap with Group X, which is directed toward a method of producing a prophylactic article wherein a vitamin or plant extract is used. This is not found persuasive because elected Group III is directed toward a product whereas Group X is directed to method claims. The search for the product and the search for the methods are not coextensive. The search of the methods would require a text search of the method steps in addition to the components necessary to complete the steps that are not required for the search of the prophylactic article. Further, even if the prophylactic article were known, the method for producing the article may be novel and unobvious in view of the preamble or active steps.

The requirement is still deemed proper and is therefore made FINAL. Claims 1-5, 9-11, 14, 15, 18-20 and 53-55 are examined on the merits.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5, 9-11, 14, 15, 18-20 and 53-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is directed toward a prophylactic article comprising an elastomeric base layer. It is unclear, however, whether the later stated anti-friction layer of the prophylactic article is *included* as a part of the internal surface of the base layer(see amendments to the claims 12/02/2004, claim 1 lines 3-4), or a separate layer distinct from the base layer(see claim 1 line 7) where a part region is positioned between the anti-friction layer and the base layer, implying each layer is separate. Appropriate correction and clarification is required.

Claim 1 is further rejected as failing to particularly point out and distinctly claim the portion of the recesses selected from a range with a lower limit of 20% and an upper limit of 95%. It is unclear what the range refers to, that is, 20% to 95% of what? See amendments to the claims 12/02/2004, claim 1 lines 13-14.

Claim 53 is directed toward a prophylactic medical glove comprising an elastomeric base layer. It is unclear, however, whether the later stated anti-friction layer of the medical glove is a part of the internal surface of the base layer(see amendments to the claims 12/02/2004, claim 53 lines 2-3), or a separate layer distinct from the base layer(see claim 1 line 6) where a part region is positioned between the anti-friction layer and the base layer, implying each layer is separate. Appropriate correction and clarification is required.

Claim 53 is further rejected as failing to particularly point out and distinctly claim the portion of the recesses selected from a range with a lower limit of 20% and an upper limit of 95%. It is unclear what the range refers to, that is, 20% to 95% of what? See amendments to the claims 12/02/2004, claim 53 lines 13-14.

Claims 2-5, 9-11, 14, 15, 18-20 and 54-55 are rejected as depending from rejected claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 9-11, 19, 20, 53 and 54 are rejected under 35 U.S.C. 102(b) as being anticipated by DRESDNER et al. (US 5,357,636, see PTO-892).

DRESDNER teaches a flexible protective medical glove having an impermeable wall with an outer layer and an inner layer. See claim 1. Each layer has an internal surface and an external surface. See, for example, Fig 1B. The layers can be latex. See claim 3. Between the layers of the glove is a non-liquid antiseptic, which can be in a powder, gel, foam, paste, magma, solid, or microscopic dust form. See col 1 lines 15-16 and Example 18. The powdered solid particles can be of any size. See col 30 line 22. The powdered solid particles can be water-insoluble fine metal grains. See col 54 line 66. The powdered particles can be of a water-soluble compound such as

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chlorhexidine gluconate. See Example 18. Colorants are used between the layers, within the layers, or within only one layer creating the color combinations of the instant invention. See col 33 line 63 to col 34 line 43. Recesses are formed in any glove as the trough between any two fingers and are shown in Figure 1. The thickness of the outer layer is between about 1 mil to about 40 mil (25 microns to about 1000 microns). See claim 1 (a). The thickness of the inner layer is about 0.3 mil to about 30 mil (7.6 to about 762 microns). See claim 1 (a).

Therefore Claims 1-5, 9-11, 19, 20, 53 and 54 are rejected under 35 U.S.C. 102(b) as being anticipated by DRESDNER.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-5, 9-11, 14, 15, 18-20 and 53-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over HAMANN (US 2004/0091504, see PTO-892) in view of SCHALLER et al (EP 0824896, see PTO-892) and in view of BUSNEL et al (US 5,024,852, see PTO-892).

HAMANN discloses a multi-layer prophylactic article or glove wherein a plant extract is incorporated into an elastomer layer of the article or glove. See page 6 paragraph [0038] and claim 37. The extract is incorporated into the inner layer, between the layers, in contact with the skin on the wearer or at all of the mentioned areas. See Figures 3-9. The plant extract contains vitamins such as E, A, C and Nopal. See claims 30, 33, 34 and 35.

HAMANN does not disclose particles or recesses contained within the anti-friction layer.

SCHALLER ('896) discloses recesses in the anti-friction layer of a medical glove, specifically with the same shape and design as those in the instant invention. See Fig. 1.

BUSNEL discloses a prophylactic article or glove wherein microcapsules are dispersed between the first and second layer of an elastomer material. See claim 1, claim 11 and column 1 lines 17-20. The microparticles are capable of containing pharmacologically active substances that are released when pressure ruptures the particles. See col 5 lines 10-22.

The prior art suggests or motivates a person in the art to combine rupturable microcapsules, which only release the active when burst thus preventing the

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degradation of the glove elastomeric material and have been known to be used between the layers of a glove. See BUSNEL column 1 lines 39-46. Furthermore, the prior art suggests that the addition of recesses can be advantageous to increasing the surface area of the glove allowing for more active to be held between the elastomeric layers. This is demonstrated in SCHALLER ('896) Figs. 4-6, especially figures 5 and 6 where a glove is being dipped into a coating solution of active compounds. As the glove is removed from the solution a greater amount of active will remain on the glove compared to a smooth elastomeric material.

Therefore, it would have been obvious to someone of ordinary skill in the art at the time of the instant invention to practice a multi-layer glove containing particles in the anti-friction layer or between the layers of the glove wherein a vitamin or plant extract is released thus resulting in the practice of the instantly claimed invention with a reasonable expectation of success.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tristan J. Mahyera whose telephone number is 571-270-1562. The examiner can normally be reached on Monday through Thursday 9am-4pm EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on 571-272-0718. The fax



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phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/TJM/

/Ardin Marschel/

Supervisory Patent Examiner, Art Unit 1614